

## **REMARKS**

### ***Status of the Claims***

The pending Office Action addresses claims 1 and 4-25, however claims 7-10 and 20-21 are withdrawn from consideration. Remaining claims 1, 4-6, 11-19, and 22-25 stand rejected.

Applicant thanks the Examiner and her Supervisor Eduardo Robert for discussing this case by telephone with Applicant's representative Christina Sperry on March 19, 2009. Applicant reminds the Examiner that during this phone call she agreed to telephone Applicant's representative to help expedite prosecution following receipt of this Amendment prior to issuing a subsequent Office Action.

### ***Amendments to the Claims***

Claim 1 is amended to recite that the inferior and superior surfaces are configured to taper away from one another toward the first end along an entire length thereof from the recess to the first end when the locking mechanism is disposed in the bore extending through the top and bottom portions. Claim 23 is amended to recite that the inferior surface of the top portion and the superior surface of the bottom portion tapering away from one another toward the first terminal end along an entire length thereof between the recess and the first terminal end *when the top and bottom portions are in the closed position*. Support for these amendments can be found throughout the specification and drawings, for example in paragraph [0048] and Figures 1B and 1C. No new matter is added.

### ***Rejections Pursuant to 35 U.S.C. § 103***

Claims 1, 4-6, 11-18, and 22-25 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,746,741 ("Kraus") in view of U.S. Patent No. 6,277,119 ("Walulik"). Applicant respectfully disagrees.

#### **Independent claim 1**

Independent claim 1 recites, in part, a clamp member having top and bottom portions with a recess formed there between. The top and bottom portions include first and second ends, and the

second ends are connected to one another such that the top and bottom portions are movable between an open position in which the top and bottom portions are spaced a distance apart from one another, and a closed position in which the clamp member is adapted to engage a spinal fixation element disposed within the recess. The top and bottom portions also include inferior and superior surfaces, respectively, that are configured to taper away from one another toward the first end along an entire length thereof from the recess to the first end when the locking mechanism is disposed in the bore extending through the top and bottom portions.

The Examiner relies on Kraus to teach the claimed invention but admits that Kraus does not disclose a locking mechanism. The Examiner thus relies on Walulik for this feature.

Kraus does not teach or suggest superior and inferior surfaces that are configured to taper away from one another toward the first end along an entire length thereof from the recess to the first end when the locking mechanism is disposed in the bore extending through the top and bottom portions. On page 2 of the Office Action the Examiner refers to Figure 5C as showing that in Kraus "the superior and inferior surfaces of the bottom and top portions [are] tapering away from each other toward the terminal end." At the outset, Applicant again notes that, as discussed in the interview, the Examiner is mischaracterizing the claim language by improperly leaving out claim requirements in formulating the rejection. Claims 1 and 23 both require that the inferior and superior surfaces taper away from each other *along an entire length thereof*. Also, claim 1 does not have any reference to a "terminal end."

The Examiner clarified by telephone on March 19, 2009 that the Examiner's position is that Figure 5C, reproduced below, illustrates the faces of the slot (22A, 22B) tapering away from each other along an entire length thereof. However, even assuming *arguendo* the Examiner's position that the faces of the slot (22A, 22B) are tapering away from each other as recited in claim 1, the faces of the slot (22A, 22B) are *not* configured to taper away from one another toward the first end along an entire length thereof from the recess to the first end *when the locking mechanism is disposed in the bore extending through the top and bottom*

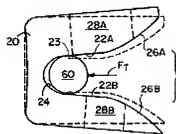


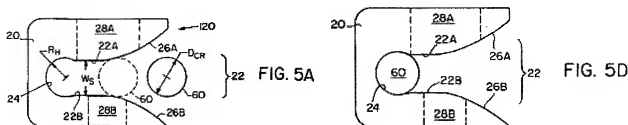
FIG. 5C

portions. Not only is the rod (60) in Figure 5C blocking portions of the bolt holes (28A, 28B) that the Examiner proposes as receiving the locking mechanism of Walulik, but a locking mechanism could not be disposed through the bolt holes (28A, 28B) with them out of alignment as illustrated in Figure 5C.

Furthermore, as clearly shown in Figures 5A and 5D, reproduced below, the faces of the slot (22A, 22B) in Kraus do not taper away from each other *along an entire length thereof* when the bolt holes (28A, 28B) are unobscured and in a position in which to receive a locking mechanism. Indeed, Kraus specifically discloses that the faces of the slot (22A, 22B) are not tapering (with emphasis added):

FIGS. 5A-5D are close-up side views of the clamp 20 demonstrating clamp deformation as the clamp 20 is transversely inserted on the body of a connecting rod 60. In FIG. 5A, the clamp 20 includes a semi-cylindrical channel 24 of radius  $R_H$ . A slot 22 parallel to the channel 24, extends to the front surface 122 of the clamp 20. The slot width  $W_S$  is slightly less than the diameter of the channel 24, where the diameter of the channel is equal to the radius  $R_H$  multiplied by 2. **The faces of the slot 22A, 22B are preferably parallel** and preferably neither slot face is tangential to the channel 24. The slot 22 tapers outwardly near its front face 26A, 26B to allow for easy alignment of the connecting rod 60 before insertion.

(Col. 7, lines 4-16.)



Thus, while faces of the slot (22) taper away from each other near the slot's front face (26A, 26B), the faces of the slot (22) cannot taper away from each other *along an entire length thereof* when a locking mechanism is disposed in the bolt holes (28A, 28B) because the faces (22A, 22B) nearest the channel (24) are clearly *parallel*. Applicant notes that the portion of the slot (22) near the front face (26A, 26B) cannot alone be the claimed inferior and superior surfaces of the top and

bottom portions because the inferior and superior surfaces are required by claims 1 and 23 to extend from a recess, e.g., the channel (24), to an end, e.g., to the tips of the front faces (26A, 26B). Claim 1 requires that the *entire* surfaces taper from the recess to the first end, not just a portion of the surfaces. Kraus therefore does not disclose the requirement of claim 1 that the superior and inferior surfaces of the bottom and top portions taper away from each other along an entire length thereof when the locking mechanism is disposed in the bore extending through the top and bottom portions.

Independent Claim 23

Independent claim 23 recites, in part, a clamp member having top and bottom portions with first and second terminal ends. The top and bottom portions are connected to one another at the second terminal end thereof such that the top and bottom portions are movable between an open position and a closed position. A recess is formed between an inferior surface of the top portion of the clamp member and a superior surface of the bottom portion of the clamp member. The inferior surface of the top portion and the superior surface of the bottom portion taper away from one another toward the first terminal end along an entire length thereof between the recess and the first terminal end when the top and bottom portions are in the closed position. Axially aligned, concentric bores extend through the top and bottom portions at a location spaced apart from the recess, the bores being configured to receive a locking mechanism for locking the top and bottom portions in the closed position.

Kraus does not disclose that the inferior surface of the top portion and the superior surface of the bottom portion *taper away from one another toward the first terminal end along an entire length thereof when the top and bottom portions are in the closed position* between the recess and the first terminal end and that *axially aligned, concentric bores extend through the top and bottom portions at a location spaced apart from the recess, the bores being configured to receive a locking mechanism for locking the top and bottom portions in the closed position*. As admitted by the Examiner and as discussed above regarding claim 1, the only potential time that the faces of the slot (22A, 22B) could possibly be tapering away from each other along an entire length thereof is when the faces (22A, 22B) are being pried apart to insert the rod (60) therebetween. However, as clearly illustrated in Figure 5C, the bolt holes (28A, 28B) are not axially aligned with the faces of the slot

(22A, 22B) tapering away from each other nor are the bolt holes (28A, 28B) configured to receive a locking mechanism in such a position. Thus, while the bolt holes (28A, 28B) may be axially aligned, e.g., as purportedly shown in Figures 5A and 5D, or the faces of the slots (22A, 22B) may be tapering, e.g., as purportedly shown in Figure 5C, the bolt holes (28A, 28B) and the faces of the slots (22A, 22B) cannot both be configured as recited in claim 23 at the same time, e.g., when the top and bottom portions are in the closed position.

Walulik is only relied on for disclosing a locking mechanism and does not remedy the deficiencies of Kraus as Walulik also fails to teach superior and inferior surfaces of the bottom and top portions that taper away from each other at all, much less that they taper away from each other along an entire length thereof. The Examiner has previously admitted this failing of Walulik, such as on page 9 in the Office Action dated June 13, 2008 ("Walulik discloses the claimed invention except for the superior and inferior surfaces of the top and bottom portions tapering away from each other toward the terminal end").

Claims 1 and 23, as well as claims 4-6, 11-18, 22, and 24-25 which depend therefrom, therefore distinguish over Walulik and Kraus, taken alone or in combination, and represent allowable subject matter.

### ***Conclusion***

Applicant submits that all claims are in condition for allowance, and allowance thereof is respectfully requested. Applicant's amendment of the claims does not constitute a concession that the claims are not allowable in their unamended form. The Examiner is encouraged to telephone the undersigned attorney for Applicant if such communication is deemed to expedite prosecution of this application.

No extension of time is believed to be due with this filing. In the event that a petition for an extension of time is required to be submitted at this time, Applicant hereby petitions under 37 CFR 1.136(a) for an extension of time for as many months as are required to ensure that the above-identified application does not become abandoned.

No fee is believed to be due with this filing. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 141449, under Order No. 101896-242.

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Respectfully submitted,

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